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10/768,023	02/02/2004	Nozomi Sawada	246853US-2 DIV	7240
22850 7590 01/21/2011 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KAU, STEVEN Y	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 01/21/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/768,023

Applicant(s)

SAWADA, NOZOMI

Examiner

STEVEN KAU

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-65 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 50-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. This is in response to Applicant(s) arguments filed on 10/19/2010.
 - The following is the current status of claims:

Claims 1-49 have been canceled and claims 50 to 65 are added new claims for examination.
 - Response to Remarks/Arguments:

(1) Applicant's arguments filed 10/19/2010, with respect to the rejection of claims 24, 26-34, 36-42 and 44-49 under 35 U.S.C. 103(a) have been fully considered but are moot in view of the new ground(s) of rejection due to the amendments.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claims 57 and 65 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 57 is dependent claim to claim 50, limitations recite, "wherein the predetermined position is a center position on the

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substitute recording medium". The recited limitations are not supported by the original specification. The closest description found from the specification is paragraph 64, (Pat Pub US2004/0156056), recites, "The image forming unit 109 develops the image data stored in the memory 108 into a data format, such as bit-map data, which can be output by the printer section 104, and outputs the developed image data to the printer section 104. The image forming unit 109 also includes a function of changing a zoom (magnification or reduction) rate, a zero position (or origin) and the developing start position of the image data, depending on an instruction from the CPU 101." But there are no embodiments or drawings indicating "wherein the predetermined position is a center position on the substitute recording medium." Claim 65 is a dependent claim to claim 58 and recites identical features as claim 57.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 50, 51, 56, 58, 59 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (US 6,611,347) in view of Matsuura et al (US 6,930,796).

(1) Regarding claim 50.

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Okada discloses image forming apparatus comprising:

a receiving unit (**referring to Transmitting/Receiving Unit 18 of Fig. 4**) configured to receive, via a network, image data and recording medium size therefor (**referring to Fig. 9, a printer control program, Step 1 input data including image data and paper size is read from the receiving buffer 501 of Fig. 5, col 11, lines 1-7**);

a reducing unit (**referring to Fig. 10, Step 6, Enlargement/Reduction mode indicating that there is a Enlargement/Reduction unit**) configured to reduce the image data based a recording medium (**referring to Fig. 10, Step 4 to Step 9, paper size is judged being different from the actual size of the paper in cassette and the size is adjusted for printing, col 12, lines 20-53**), when a recording medium having the recording medium size is unavailable and the image data is to be formed on the substitute recording medium that is smaller than the recording medium size; and

a forming unit (**Printing Unit 17 of Fig. 4**) configured to form on the recording medium the image data that is reduced by the reducing unit (**referring to Fig. 10, Steps 4 to 17, image is formed by the print engine, col 12, lines 20-53**).

Okada does not explicitly teach that reducing the image data based on a size of a substitute recording medium, when a recording medium having the recording medium size is unavailable and the image data is to be formed on the substitute recording medium that is smaller than the recording medium size.

Matsuura teaches that reducing the image data based on a size of a substitute recording medium (**referring to Fig. 2, Steps S11-S19, the required paper is not available and substitute paper is used**), when a recording medium having the

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recording medium size is unavailable and the image data is to be formed on the substitute recording medium that is smaller than the recording medium size (**page is printed on a reduced size on a smaller size paper, Abstract and col 4, lines 33-42**).

Having an image forming apparatus of Okada reference and then given the well-established teaching of de Matsuura reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Okada reference by applying the known technique of "reducing the image data based on a size of a substitute recording medium, when a recording medium having the recording medium size is unavailable and the image data is to be formed on the substitute recording medium that is smaller than the recording medium size" as taught by Matsuura reference. The motivation for doing so would have been to improve the image reproduction throughput and thus to improve the productivity by using substitute paper with close size when the designated paper size unavailable without hampering print jobs requested by other users (col 1, line 39-43, Matsuura), and further the disclosure provided could easily be established for one another with predictable results.

(2) Regarding claim 51, in accordance with claim 50.

Okada does not explicitly teach that forming the image data received by the receiving unit, without reduction by the reducing unit, on the substitute recording medium that is formed by one of a plurality of recording media having a smallest size amongst the plurality of recording media, when a recording medium having the recording medium size received by the receiving unit is unavailable and one of the

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plurality of recording media having sizes larger than the recording medium size received by the receiving unit is to be used as the substitute recording medium.

Matsuura teaches teach that forming the image data received by the receiving unit, without reduction by the reducing unit, on the substitute recording medium that is formed by one of a plurality of recording media having a smallest size amongst the plurality of recording media, when a recording medium having the recording medium size received by the receiving unit is unavailable and one of the plurality of recording media having sizes larger than the recording medium size received by the receiving unit is to be used as the substitute recording medium **(there are scenarios of either printing on a smaller size paper or on a large size paper when the designated paper size become not available; thus, no reduction is required when printing the received image data on a large size of paper, col 4, lines 33-46)**.

Having an image forming apparatus of Okada reference and then given the well-established teaching of de Matsuura reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Okada reference by applying the known technique of "forming the image data received by the receiving unit, without reduction by the reducing unit, on the substitute recording medium that is formed by one of a plurality of recording media having a smallest size amongst the plurality of recording media, when a recording medium having the recording medium size received by the receiving unit is unavailable and one of the plurality of recording media having sizes larger than the recording medium size received by the receiving unit is to be used as the substitute recording medium" as taught by

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Matsuura reference. The motivation for doing so would have been to improve the image reproduction throughput and thus to improve the productivity by using substitute paper with close size when the designated paper size unavailable without hampering print jobs requested by other users (col 1, line 39-43, Matsuura), and further the disclosure provided could easily be established for one another with predictable results.

(3) Regarding claim 56, in accordance with claim 50.

Okada discloses wherein the forming unit forms the image data received by the receiving unit at a predetermined position on the substitute recording medium (**referring to Fig. 10, Steps 4, and 6-9, bi-map image is developed prior to form image data on the recording paper, col 12, lines 20-29 and line 45-53**).

(4) Regarding claim 58.

Claim 58 is directed toward an image forming method and reciting corresponding features as claim 50. Thus, claim 58 is rejected for the same reason discussed in claim 50 above.

(5) Regarding claim 59, in accordance with claim 58.

Claim 59 is directed toward an image forming method and reciting corresponding features as claim 51. Thus, claim 59 is rejected for the same reason discussed in claim 51 above.

(6) Regarding claim 64, in accordance with claim 58.

Claim 64 is directed toward an image forming method and reciting corresponding features as claim 56. Thus, claim 64 is rejected for the same reason discussed in claim 56 above.

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6. Claims 52, 53, 60 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (US 6,611,347) in view of Matsuura et al (US 6,930,796) as applied to claim 50 above, and further in view of Ishikura et al (US RE37,812).

(7) Regarding claim 52, in accordance with claim 50.

Okada does not explicitly teach wherein one of the plurality of recording media having a size B4 is used as the substitute recording medium when the recording medium size received by the receiving unit is a size A4, a recording medium having the size A4 is unavailable, and one of the plurality of recording media having a size larger than the size A4 is to be used as the substitute recording medium, one of the plurality of recording media having a size A3 is used as the substitute recording medium when a recording medium having the size B4 is unavailable, and the forming unit forms the image data received by the receiving unit, without reduction by the reducing unit, on the substitute recording medium having the B4 size or the A3 size.

Ishikura teaches that one of the plurality of recording media having a size B4 is used as the substitute recording medium when the recording medium size received by the receiving unit is a size A4, a recording medium having the size A4 is unavailable, and one of the plurality of recording media having a size larger than the size A4 is to be used as the substitute recording medium, one of the plurality of recording media having a size A3 is used as the substitute recording medium when a recording medium having the size B4 is unavailable, and the forming unit forms the image data received by the receiving unit, without reduction by the reducing unit, on the substitute recording

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medium having the B4 size or the A3 size (**sheet size of B4 is used for A4 size of original, col 10, lines 43-45**).

Having an image forming apparatus of Okada reference and then given the well-established teaching of de Ishikura reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Okada reference by applying the known technique of "one of the plurality of recording media having a size B4 is used as the substitute recording medium when the recording medium size received by the receiving unit is a size A4, a recording medium having the size A4 is unavailable, and one of the plurality of recording media having a size larger than the size A4 is to be used as the substitute recording medium, one of the plurality of recording media having a size A3 is used as the substitute recording medium when a recording medium having the size B4 is unavailable, and the forming unit forms the image data received by the receiving unit, without reduction by the reducing unit, on the substitute recording medium having the B4 size or the A3 size" as taught by Ishikura reference. The motivation for doing so would have been to improve the image reproduction throughput and thus to improve the productivity by using substitute paper with close size when the designated paper size unavailable without hampering print jobs requested by other users, and further the disclosure provided could easily be established for one another with predictable results.

(8) Regarding claim 53, in accordance with claim 50.

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Okada does not teach a storage unit configured to store a priority order of substitute recording medium sizes to be used when a recording medium having the recording medium size received by the receiving unit is unavailable.

Ishikura teaches that a storage unit configured to store a priority order of substitute recording medium sizes to be used when a recording medium having the recording medium size received by the receiving unit is unavailable (**substitute relationship of Fig. 6 is stored in ROM 142, col 19, lines 31-39**).

Having an image forming apparatus of Okada reference and then given the well-established teaching of de Ishikura reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Okada reference by applying the known technique of "a storage unit configured to store a priority order of substitute recording medium sizes to be used when a recording medium having the recording medium size received by the receiving unit is unavailable" as taught by Ishikura reference. The motivation for doing so would have been to enhance the image forming apparatus of Okada so that the image reproduction process, e.g. of Fig. 10 would be continued without interruption, and further the disclosure provided could easily be established for one another with predictable results.

(9) Regarding claim 60, in accordance with claim 58.

Claim 60 is directed toward an image forming method and reciting corresponding features as claim 52. Thus, claim 60 is rejected for the same reason discussed in claim 52 above.

(10) Regarding claim 61, in accordance with claim 58.

Claim 61 is directed toward an image forming method and reciting corresponding features as claim 53. Thus, claim 61 is rejected for the same reason discussed in claim 53 above.

7. Claims 54, 55, 62 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (US 6,611,347) in view of Matsuura et al (US 6,930,796) as applied to claims 50 and 58 above, and further in view of Ito (US 4,908,672).

(11) Regarding claim 54, in accordance with 50.

Okada does not teach that a selecting unit configured to select one of forming the image data reduced by the reducing unit on the substitute recording medium based on the size of the substitute recording medium and forming the image data, received by the receiving unit on the substitute recording medium without reduction by the reduction unit.

Ito teaches that a selecting unit (**CPU1 of copier machine, col 5, lines 20-24**) configured to select one of forming the image data reduced by the reducing unit on the substitute recording medium based on the size of the substitute recording medium and forming the image data, received by the receiving unit on the substitute recording medium without reduction by the reduction unit (**referring to Fig. 4, Step #2, paper selection routine and Fig. 5, col 5, lines 20-51**).

Having an image forming apparatus of Okada reference and then given the well-established teaching of de Ito reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Okada reference by

applying the known technique of "a selecting unit configured to select one of forming the image data reduced by the reducing unit on the substitute recording medium based on the size of the substitute recording medium and forming the image data, received by the receiving unit on the substitute recording medium without reduction by the reduction unit" as taught by Ito reference. The motivation for doing so would have been to enhance the image forming apparatus of Okada so that the image reproduction process, e.g. of Fig. 5 would be continued without interruption (col 1, lines 46-63, Ito), and further the disclosure provided could easily be established for one another with predictable results.

(12) Regarding claim 55, in accordance with claim 50.

Okada does not teach a selecting unit configured to select one of forming the image data reduced by the reducing unit on the substitute recording medium based on the size of the substitute recording medium and forming the image data received by the receiving unit in parts on a plurality of substitute recording media without reduction by the reduction unit.

Ito teaches a selecting unit (**CPU1 of copier machine, col 5, lines 20-24**) configured to select one of forming the image data reduced by the reducing unit on the substitute recording medium based on the size of the substitute recording medium and forming the image data received by the receiving unit in parts on a plurality of substitute recording media without reduction by the reduction unit (**referring to Fig. 4, Step #2, paper selection routine and Fig. 5, col 5, lines 20-51**).

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Having an image forming apparatus of Okada reference and then given the well-established teaching of de Ito reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Okada reference by applying the known technique of "a selecting unit configured to select one of forming the image data reduced by the reducing unit on the substitute recording medium based on the size of the substitute recording medium and forming the image data, received by the receiving unit on the substitute recording medium without reduction by the reduction unit" as taught by Ito reference. The motivation for doing so would have been to enhance the image forming apparatus of Okada so that the image reproduction process, e.g. of Fig. 5 would be continued without interruption (col 1, lines 46-63, Ito), and further the disclosure provided could easily be established for one another with predictable results.

(13) Regarding claim 62, in accordance with claim 58.

Claim 62 is directed toward an image forming method and reciting corresponding features as claim 54. Thus, claim 62 is rejected for the same reason discussed in claim 54 above.

(14) Regarding claim 63, in accordance with claim 58.

Claim 63 is directed toward an image forming method and reciting corresponding features as claim 55. Thus, claim 63 is rejected for the same reason discussed in claim 55 above.

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8. Claims 57 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al (US 6,611,347) in view of Matsuura et al (US 6,930,796) as applied to claims 50 and 58 above, and further in view of Tabata (US 5,448,346).

(15) Regarding claim 57, in accordance with claim 50.

Okada does not teach wherein the predetermined position is a center position on the substitute recording medium.

Tabata teaches that the predetermined position is a center position on the substitute recording medium (**Image is formed at the center of recording paper, Abstract, col 7, lines 37-47 and Fig. 3**).

Having an image forming apparatus of Okada reference and then given the well-established teaching of de Ito reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Okada reference by applying the known technique of "the predetermined position is a center position on the substitute recording medium" as taught by Tabata reference. The motivation for doing so would have been to improve the image reproduction process adjustment to prevent image reproduction out of balance if the designated paper size is unavailable and a substitute recording medium is used, e.g. of Figs. 10A and 10B (col 2, lines 3-10, Tabata), and further the disclosure provided could easily be established for one another with predictable results.

(16) Regarding claim 65, in accordance with claim 58.

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Claim 65 is directed toward an image forming method and reciting corresponding features as claim 57. Thus, claim 65 is rejected for the same reason discussed in claim 57 above.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Contact Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Kau whose telephone number is 571-270-1120 and fax number is 571-270-2120. The examiner can normally be reached on Monday to Friday, from 8:30 am -5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Steven Kau/
Examiner, Art Unit 2625
December 27, 2010

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625

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